



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

fw

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,120	01/26/2001	Stefan Johansson	15292.4	7001

7590 05/12/2006

RICK D. NYDEGGER  
WORKMAN NYDEGGER & SEELEY  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, UT 84145

EXAMINER

MOORE, IAN N

ART UNIT PAPER NUMBER

2616

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/771,120	<b>Applicant(s)</b> JOHANSSON, STEFAN	
	<b>Examiner</b> Ian N. Moore	<b>Art Unit</b> 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21 and 23 is/are rejected.
- 7) ☒ Claim(s) 10 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2-1-06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because it contains the phrase, "invention" in lines 1 and 9, which can be implied. Applicant is reminded of the proper language and format for an abstract of the disclosure. Correction is required. See MPEP § 608.01(b).

It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Double Patenting (Provisional)*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 13 of copending Application No.

09/771,121 (Johansson). Although the conflicting claims are not identical, they are not

Art Unit: 2616

patentably distinct from each other because claims 1 and 13 of the instant application merely broadens the scope of the claims 1 and 13 of the Johansson by eliminating the elements and their functions of the claims (i.e. eliminating "...that is included in a set of one or more predefined network address stored by the wireless mobile communication station, a packet data session, verifying as authentic") and rewording the identical steps (i.e. "determining if the received network address matches a predefined network address of the originator" and "verifying the identify of the originator at the wireless communicating station" as "acquiring at the wireless mobile communication station an identify corresponding to the received network address"). Thus, it would have been obvious to one skilled in the art to rename the same functional components in order to achieve mobile unit's determination/verification of received messages before establishing connection. Moreover, it has been held that the omission an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd.App.1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2616

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Seazholtz (US005920821A).

**Regarding Claim 1 and 13,** Seazholtz discloses a method at a wireless communication station (see FIG. 1, Cellular subscriber station 12) for enabling the wireless mobile communication station to selectively permit desired packet data (see col. 10, line 50-65; see col. 23, line 16-40; Cellular packet data) to be pushed from an originator of packet data (see FIG. 1, Cellular system 14 A or B) to the wireless mobile communication station, the station being operatively associated with a wireless communication network providing packet data transferring services (see col. 10, line 50-65; see col. 23, line 16-40; CDPD network), the method comprising the acts of:

receiving at the wireless mobile communication station a network address of an originator of packet data that is attempting to push the packet data to the mobile communication station (see FIG. 5, Step 501, 502; see col. 14, line 20-57; at the subscriber station, System ID (SID) of the cellular system 14 that is trying to send packet data is received/scanned);

acquiring at the wireless mobile communication station an identity corresponding to the received network address (see FIG. 5, step 502; cellular system SID is selected/acquired in associating with its cellular system name/frequency-band (i.e. cellular A, B, or PCS); see col. 14, line 35-57;

determining at the wireless mobile communication station, based upon the identity, whether or not packet data reception from said originator is desired (see FIG. 5, step 503 and

504; determining the selected cellular system name/frequency-band by comparing stored a list of SIDs, whether or not the selected cellular system provider provides preferential treatment to the subscriber; see col. 14, line 57 to col. 15, line 16)

and establishing at the wireless mobile station, only after it is determined that the packet data reception from said originator is desired, a packet data session with said originator (see FIG. 5, step 504, 505, 506; after selecting a preferred cellular system provider, subscriber station acquires carrier signal from the provider for registration to establish communication; see col. 15, line 10-27);

thereby enabling the wireless mobile communication station to selectively permit desired packet data to be pushed from said originator to the wireless communication station (see col. 15, line 16-42; thereby providing the subscriber to select desired/preferred packet data system provider to receive the packet data).

6. Claims 1,2,4-7,11-14,16-19 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Andersson (US006047194A).

**Regarding Claim 1 and 13**, Andersson discloses a method at a wireless communication station (see FIG. 1, Mobile terminal 14) for enabling the wireless mobile communication station to selectively permit desired packet data to be pushed from an originator of packet data (see FIG. 1, from Internet Host 12) to the wireless mobile communication station, the station being operatively associated with a wireless communication network providing packet data transferring services (see col. 3, line 40-47; packet switching network), the method comprising the acts of:

receiving at the wireless mobile communication station a network address of an originator of packet data that is attempting to push the packet data to the mobile communication station (see FIG. 2, 114; see FIG. 4, step 168; see col. 5, line 65 to col. 6, line 7; see col. 7, line 40-65; see col. 8, line 45-56; see col. 10, line 57-57; mobile terminal receives an SMS message with in identifier (i.e. Origination Address (OA) according to GSM's SMS standard) of the origination source/host that is trying to send packet data);

acquiring at the wireless mobile communication station an identity corresponding to the received network address (see FIG. 4, step 172; see col. 6, line 4-10; see col. 7, line 60 to col. 8, line 2, 59-65; see col. 9, line 32-35; see col. 10, line 50-56; detecting/acquiring an identity of the origination source associating with received identifier/OA);

determining at the wireless mobile communication station, based upon the identity, whether or not packet data reception from said originator is desired (see FIG. 4, step 174; see col. 6, line 5-14; see col. 8, line 3-14, 59-65; see col. 9, line 35-40; select whether to permit transmission of packet data responsive to the identity of origination source);

and establishing at the wireless mobile station, only after it is determined that the packet data reception from said originator is desired, a packet data session with said originator (see FIG. 4, step 176; see col. 6, line 10-14; see col. 8, line 10-14, 60-67; see col. 9, line 40-44; after permitting/accepting packet transmission from origination source, a registration is initiated to established connection);

thereby enabling the wireless mobile communication station to selectively permit desired packet data to be pushed from said originator to the wireless communication station (see col. 8,

line 10-14, 60-67; col. 8, line 65 to col. 9, line 6; thereby providing the mobile terminal to select desired origination source to receive the packet data).

**Regarding Claim 2 and 14**, Andersson discloses displaying said identity on displaying means (see FIG. 3, Display 144) associated with the wireless communication station (see col. 8, line 32-35); and

accepting, from a user of the wireless station, either a confirmation or a rejection regarding reception of packet data from said originator having the displayed identity (see col. 8, line 44; user of mobile terminal performs the selection to grant).

**Regarding Claim 4 and 16**, Andersson discloses wherein said network address of said receiving act is received in a short message (see col. 6, line 1-10; SMS), the short message being received from a short message service provided by said wireless communication network (see FIG. 1, Short Message service-center, SMS-C 56; see col. 5, line 60 to col. 6, line 10).

**Regarding Claim 5 and 17**, Andersson discloses establishing a packet data session using said identity (see col. 5, line 65 to col. 6, line 14; see col. 7, line 40-65; see col. 8, line 10-14, 45-67; see col. 9, line 40-44; see col. 10, line 57-57).

**Regarding Claim 6 and 18**, Andersson discloses wherein said network address is an Internet Protocol address (see col. 7, line 40-35; IP address).

**Regarding Claim 7 and 19**, Andersson discloses establishing a packet data session using said identity (see FIG. 4, step 176; see col. 6, line 10-14; see col. 8, line 10-14, 60-67; see col. 9, line 40-44; establishing packet transmission using identify of origination source).

**Regarding Claim 11**, Andersson discloses a computer-readable medium storing computer-executable components for causing a wireless communication station to perform the



acts recited in claim 1 when the computer-executable components are run on microprocessor included by a wireless communication station (see FIG. 3, mobile terminal 14 contains processor and memory; see col. 8, line 14-32).

**Regarding Claim 12 and 23**, Andersson discloses a wireless communication station (see FIG. 3, mobile terminal 14) arranged to be operatively associated with a wireless communication network (see FIG. 1, mobile network) providing packet data transferring services, wherein the wireless communication station includes processing means (see FIG. 3, mobile terminal 14 contains processor), memory means (see FIG. 3, mobile terminal 14 contains memory), interface circuitry means (see FIG. 3, Rx circuitry 142 with radio antenna interface) and user interface means (see FIG. 3, Display 144 and selector 146) for performing the acts recited in claim 1 (see col. 8, line 14-32), thereby facilitating desired packet data to be pushed from an originator to the wireless communication station (see col. 15, line 16-42; thereby providing the subscriber to select desired/preferred packet data system provider to receive the packet data).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Wang (US006614774B1).

**Regarding Claim 3 and 15**, Andersson discloses establishing a packet data session as set forth above in claim 1 and 13. Andersson does not explicitly disclose an address translation server; and requesting translation of the network address to the corresponding identity. However, Wang teaches establishing a packet data session (see FIG. 4, reverse DNS request/lookup) with an address translation server (see FIG. 4, DNS server 118); and

requesting translation of the network address (see FIG. 4, IP address) to the corresponding identity (see FIG. 4, host name; see col. 8, line 32-47). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide DNS server and reverse DNS lookups, as taught by Wang in the system of Andersson, so that it would avoid DNS lookup failures and does not introduce delays and cost effective system; see Wang col. 5, line 50-60.

9. Claims 8,9, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Brothers (US006822955B1).

**Regarding Claim 8,9,20 and 21**, Andersson discloses said identity is the originator name as set forth above claims 1 and 13, and a network server (see FIG. 1, SMS-C, VPMSC 44, or GPMSC 46). Andersson does not explicitly disclose wherein said identity is an Internet domain host name of a network server. However, Brothers teaches wherein said identity is an Internet domain host name of a network server (see FIG. 13, a server Internet domain host name, "Disney.com"). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an Internet domain host name as an identify, as

taught by Brothers in the system of Andersson, so that it would provide full transparent IP mobility services for clients; see Brothers col. 1, line 60 to col. 2, line 5.

***Allowable Subject Matter***

10. **Claims 10 and 22** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ian N. Moore whose telephone number is 571-272-3085. The examiner can normally be reached on 9:00 AM- 6:00 PM.

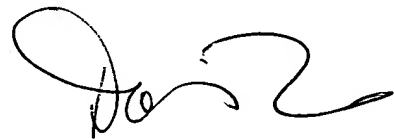
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on 571-272-7629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*JSM*

INM  
5-8-06



**DORIS H. TO**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**